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EXAMINER

O'CONNOR, GERALD J

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20060331

Application Number: 09/935,287
Filing Date: August 22, 2001
Appellant(s): Kopelman et al.

Gregory S. Bernabeo
(Reg. No. 44,032)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal filed
January 13, 2006.

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(Assignee of record, *EBay, Inc.*)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (None.)

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(Claims 1-13 and 21-32 are pending, rejected, and appealed.)

(Claims 14-20 have been cancelled.)

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(None.)

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

- I. Claims 1-13 and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde et al. (US 5,283,731).

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

5,283,731	Lalonde et al.	2/1994
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(9) *Grounds of Rejection*

- I. Claims 1-13 and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde et al. (US 5,283,731).

Lalonde et al. discloses a computer-implemented method for listing an independent seller's good for sale using a CPU, a memory operatively connected to the CPU and a program stored in the memory and executable by the CPU for presenting the good for sale, the method

comprising: receiving from a seller information identifying a good, the information comprising a series of tones generated by depression of keys of a telephone; and presenting the good for sale, but the presentation of the good for sale in the pre-Internet method of Lalonde et al. is not on a website. However, using a website to present a good for sale is a well known, hence obvious, step to follow for those of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lalonde et al. so as to use a website for presenting the good for sale, as is well known to do, in order to present the good for sale to as wide an audience as possible by using the Internet, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 2, the method of Lalonde et al. includes that the series of tones navigates through a voice-prompt system.

Regarding claims 3-5, the method of Lalonde et al. includes that the telephone is a touch tone telephone and that the series of tones generated comprises tones generated by depressing the telephone's keys, but does not include that the tones generated indicate a sequence corresponding to an alphanumeric sequence of a universal product code (UPC), international standard book number (ISBN), or other standard identification code. However, standard product identification codes such as UPC and ISBN number are well known, hence obvious, to those of ordinary skill in the art, as a convenient means for identifying particular goods or products. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lalonde et al. so as to allow a standard identification

code such as UPC or ISBN to be entered in order to conveniently identify the good being or product being (re)sold, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 6 and 7, the method of Lalonde et al. includes retrieving information in real time relating to the good from a database; wherein the information retrieved is used to present the good for sale.

Regarding claim 8, the method of Lalonde et al. includes that the information identifying the good identifies a characteristic of the good in addition to an identity of the good.

Regarding claims 9 and 10, the method of Lalonde et al. includes receiving from the seller a selected sale price, but does not explicitly disclose anyone determining and recommending to the seller any recommended sales price. However, a seller soliciting recommendations for a recommended sales price when selling a used good is a well known, hence obvious, step to follow when selling a good. For example, checking the Blue Book value for a used car before determining an asking price for the car. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lalonde et al. so as to include someone/something determining and recommending to the seller a recommended sales price, so that the seller would be able to price the good in accordance with the market for the good, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 11 and 12, the method of Lalonde et al. includes receiving a seller identification code which is recognizable in association with the seller, the seller identification code comprising tones generated by depressing the telephone's keys in a sequence corresponding to an alphanumeric sequence associated with the seller.

Regarding claim 13, the method of Lalonde et al. does not explicitly include that the seller identification code is a telephone number of the telephone from which the seller is calling, nor that the determination of a recommended sales price for the good comprises recognizing the telephone's telephone number by a caller identification technique. However, using a telephone number as an ID number for an account, determining a caller's telephone number by means of a caller ID technique, and recommending a sales price based on the seller's geographic area as determined by either of postal code or telephone number area code, are all well known, hence obvious, steps to perform when practicing such a method of selling goods. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lalonde et al. so as to include that the seller identification code would be the telephone number of the telephone from which the seller was calling, and that the determination of a recommended sales price for the good comprises recognizing the telephone's telephone number by a caller identification technique, as is well known to do, in order to provide as accurate a recommendation as possible by taking into account the geographic area of the seller, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

(10) Response to Argument

I. Claims 1-13 and 21-32 are unpatentable under 35 U.S.C. 103(a) for being obvious over Lalonde et al. (US 5,283,731).

Regarding the argument that the Lalonde et al. reference “fails to teach or suggest using an IVR, or using touch tones, to provide information identifying a good,” Lalonde et al. indeed certainly disclose, and at least suggest, using an IVR, or using touch tones, to provide information identifying a good, since the IVR system, in at least one disclosed embodiment, is the *only* interface used to placing the listing, which listing obviously *requires* that the good being sold *necessarily* be identified, since Lalonde et al. disclose that their system can indeed be entirely automated in one embodiment, though they acknowledge that their preferred embodiment is a semi-automated system that hands off the caller/seller to a human operator at some point.

Applicant’s argument that the automated embodiment of Lalonde et al. is semi-automated and still hands off the call to an operator to create the ad is completely in error. See, for example, column 6, lines 3-18. Lalonde et al. describe, in lines 8-14, certain functionality wherein the human operator acts as a middleman between the DBS (automated ad listing system) and the caller/seller, relaying the DBS prompts/output to the caller and inputting the caller’s responses/input into the DBS:

“the DBS begins prompting the operator at terminal 40 for information relating to the ad. In turn, the operator relays these requests to the seller via headset 42 and switch 12, receives the seller’s responses via the same path, and inputs such responses to DBS 16, to create a new ad in ad database 30.”

Immediately thereafter, in lines 14-18, Lalonde et al. then disclose that this step could be automated using the IVR (i.e., without the human operator as middleman):

“Although this step could be automated using the IVR, it is generally preferable to use a human operator as an interface, because of the amount of variability involved in placing an ad, explaining to the seller the options, etc.”

Lalonde et al., therefore, indeed *disclose* a fully automated system for gathering the ad information, even if that embodiment is not considered their preferred embodiment.

Applicant’s further argument that the system of Lalonde et al. could not function by inputting the UPC codes via touch tone because the human operator could not interpret the tones is disingenuous in that the argument ignores the fact that the embodiment of Lalonde et al. contemplated by the rejection as being used in conjunction with inputting the UPC codes using the touch tone keypad of the telephone is the automated embodiment, not the operator-assisted embodiment, and so is therefore completely and utterly non-responsive to the applied rejection.

Regarding the argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., retrieving a pre-stored book cover from a database) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the argument that Lalonde et al. fail to expressly disclose that “the presentation of the good for sale is performed in real time,” it is the finding of the examiner, as

trier-of-fact, that the presentation of the good for sale is performed in real time in the automated embodiment of Lalonde et al., since one of ordinary skill in the art would instantly and unquestionably recognize that all ads in the database of Lalonde et al. would be available as soon as they were added to the database, and since *express* disclosure of features that are necessarily, thus inherently, present is not required, as it is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, see *In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Regarding the argument that Lalonde et al. fail to disclose use of a standard identification code (e.g., UPC code, ISBN number, etc.), the argument is disingenuous because it is non-responsive to the rejection, which explicitly acknowledged and addressed the omission. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding the argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the knowledge generally available to one of ordinary skill in the art included the use of standard identification numbers to identify products, hence the motivation to use the pre-existing system of standardized identification numbers to conveniently and uniquely identify the product to be sold.

Furthermore, it is the finding of the examiner, as trier-of-fact, that it would have been within the ability of one of ordinary skill in the art to have used the system of Lalonde et al. with a standardized number (UPC, ISBN, whatever) instead of any other part number, model number, or alphanumeric descriptor, with neither undue experimentation, nor risk of unexpected results. It is well settled that the main test for any conclusion of obviousness with respect to any proposed or hypothetical combination or modification of prior art knowledge is whether or not such a combination or modification could have been performed or implemented by any person of ordinary skill in the art, at the time of the invention, with neither undue experimentation, nor risk of unexpected results. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

Regarding the argument that Lalonde et al. fails to disclose a characteristic of the good (e.g., new or used and condition, such as like-new, worn, etc.) incapable of being identified from the standard identification code (e.g., UPC code or ISBN number) alone, Lalonde et al. indeed disclose a characteristic of the good incapable of being identified from the standard identification of the good. For example, the geographic location of the seller/good (column 6, line 51).

Regarding the argument that Lalonde et al. fail to disclose retrieving a recommended selling price from a database, the argument is disingenuous because it is non-responsive to the rejection, which explicitly acknowledged and addressed the omission, giving the example of looking up (i.e., retrieving from a database) a blue book recommended selling price for a car. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding the argument that Lalonde et al. provide “absolutely no teaching or suggestion of any recognizable seller identification code that identifies a seller,” the argument is disingenuous, since even a cursory review of the reference reveals that Lalonde et al. explicitly discloses using a seller identification code that identifies a seller. For example, lines 20-22 of column 6 (the next few lines after the quoted section above, which particular part applicant claims to have been unable to find):

“In step 150, the operator asks the seller to identify itself, such as by supplying a seller ID or other identifying information.”

Regarding the argument that Lalonde et al. fail to disclose that a particular call is associated with a particular seller, Lalonde et al. indeed disclose identifying the seller that has called-in. See, in particular, element 152 of Figure 3, and the database 34 of sellers shown in Figure 1, neither of which could exist without a unique identifier for each seller.

Regarding the argument that the examiner has asserted motivation to combine references based on common knowledge or common sense, the examiner has made no such assertion. Applicant is confusing the question of what is or is not prior art (“common knowledge” acceptable) with the question of motivation to modify or combine (“common sense” not acceptable).

Regarding the argument that Lalonde et al. fail to disclose “that the seller identification code is a telephone number of the telephone from which the seller is calling,” the argument is non-responsive to the applied rejection, since the rejection explicitly acknowledged and addressed the cited deficiency of the Lalonde et al. disclosure relative to the instant invention. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding the argument that Lalonde et al. fails to disclose the basis for the recommended sales price being a function of the seller’s geographic area, applicant’s argument is again non-responsive to the rejection, and again, confused between “contents and scope of prior art” and “motivation to combine.” Geographic area (e.g., ZIP code) is indeed well known to those of ordinary skill in the art as being a basis for a recommended sales price. For example, any blue book value for a particular car is based, in part, on the ZIP code where the car is located.

Regarding the argument that “conclusory statements asserting *motivation* that are based on “common knowledge or common sense” are not sufficient” (bold italics emphasis added, underlining in original) as an evidentiary basis for a rejection, applicant is actually correct,

though the argument is completely irrelevant since no such motivation has been asserted.

Applicant is again confused between “scope and contents of prior art” and “motivation to combine prior art.” Again, the rationale supporting an obviousness rejection may indeed be based on common knowledge in the art or ‘well-known’ prior art. See MPEP § 2144.03.

Furthermore, as applicant had failed to seasonably provide any *proper* traverse to the examiner’s stated positions as to what is well known *prior art*, and, as any traverse (proper or not) would no longer be considered seasonable, the objects of the well known statements have since been deemed and considered to be admitted prior art in accordance with MPEP § 2144.03(C).

For all of the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "3/31/06".


Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627

GJOC

March 31, 2006

Appeal Conference Held:

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